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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/601,846	09/19/2000	Eduard Bruck	22599 N1PCTU	3778

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EXAMINER

STRIMBU, GREGORY J

ART UNIT PAPER NUMBER

3634

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/601,846	Applicant(s) BRUCK, EDUARD	
	Examiner Gregory J. Strimbu	Art Unit 3634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2005 and 30 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-37 and 39-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-37 and 39-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/4/00</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

Claims 23-37 and 39-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as “zones of a single body” on line 10 of claim 23 render the claims indefinite because it is unclear what the applicant is attempting to set forth. What comprises a zone? Recitations such as “formed as a bead” on line 15 of claim 23 render the claims indefinite because it is unclear if the sealing body is actually a bead or merely formed as a bead and then later changed when combined with the internal element. Recitations such as “soft” on line 3 of claim 27 render the claims indefinite because they are relative terms whose meaning cannot be readily ascertained by one with ordinary skill in the art and are not defined by the specification. Recitations such as “a molded-in bush” on line 2 of claim 28 render the claims indefinite because it is unclear what the applicant is attempting to set forth. Recitations such as “formed by a wall offset so as to mold a foam injection-formed bead” on lines 2-3 of claim 35 render the claims indefinite because it is unclear what the applicant is attempting to set forth. Recitations such as “an unfoamed boundary layer” on lines 3-4 of claim 36 render the claims indefinite because it is unclear if the applicant is referring to the solid boundary layers set forth above or is attempting to set forth another element of the invention in addition to the ones set forth above. Recitations such as “the injection-formed material” on line 2 of claim 37 render the claims indefinite because they lack antecedent basis. Recitations such as “high melting strengths polymer” on line 3 of claim 37 render the

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claims indefinite because it is unclear what comprises a high strengths. Recitations such as "end face" on line 3 of claim 39 render the claims indefinite because it is unclear what element of the invention includes the end face to which the applicant refers. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 41 recites the broad recitation inserts, and the claim also recites bushes and threaded inserts which is the narrower statement of the range/limitation. Recitations such as "said predetermined amount . . . internal element" on lines 3-5 of claim 42 render the claims indefinite because it is unclear how removed material can extend through the internal element. Recitations such as "means" on line 3 of claim 43 render the claims indefinite because the applicant has attempted to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by

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the word(s) preceding or following "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). Recitations such as "the outer skin" on line 4 of claim 44 render the claims indefinite because they lack antecedent basis.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23, 24, 26-29, 31-33, 36, 37, 39, and 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Basson et al. in view of Gonas. Basson et al. discloses a motor vehicle door internal element 201 to be arranged between a door outer side 2 of a motor vehicle door and an inner lining 1 wherein the motor vehicle door internal element is a support and sealing element, and wherein the motor vehicle door internal element further comprises a sealing body 204 formed as a bead and disposed at an edge of the motor vehicle door internal element as shown in figure 3, cable holders (not numbered, but shown in figure 3 as the generally horizontal grooves at the left hand end of the internal element), a cable bushing 141, a molding in bush 151, a support plate (not numbered, but comprising the bottom of the cavity 211 as shown in figure 3), a partial wall offset 211, threaded inserts 351. Basson et al. is silent concerning boundary layers and a foamed central layer.

However, Gonas discloses a motor vehicle internal element 36 having two solid boundary layers 42 and a foamed, porous central layer 64, lying between the two solid boundary layers as shown in figure 2 wherein said solid boundary layers and said foamed, porous central layer are made of the same thermoplastic material (see column 6, lines 46-49) and are zones of one single body, produced by a single foaming process, wherein said solid boundary layers are formed integrally with each other at an end face of the motor vehicle door internal element.

It would have been obvious to one of ordinary skill in the art to provide Basson et al. with a sandwich construction, as taught by Gonas, to improve the energy absorbing properties of the door.

With respect to claim 36, one of ordinary skill in the art is expected to routinely experiment with parameters so as to ascertain the optimum or workable ranges for a particular use. Accordingly, it would have been no more than an obvious matter of engineering design choice, as determined through routine experimentation and optimization, for one of ordinary skill to provide the internal element with a density that varies over a cross section between 0.7 and 1.4 g/cm³ in an unfoamed boundary layer and is between 0.1 and 0.6 g/cm³ in the foamed central layer.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Basson et al. in view of Gonas as applied to claims 23, 24, 26-29, 31-33, 36, 37, 39, and 41-43 above, and further in view of Staser et al. '096. Staser et al. '096 discloses an internal door element comprising a mounting collar (not numbered, but shown in figure 1).

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It would have been obvious to one of ordinary skill in the art to provide Basson et al., as modified above, with a mounting collar, as taught by Staser et al. '096, to more easily provide the vehicle door with a speaker.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Basson et al. in view of Gonas as applied to claims 23, 24, 26-29, 31-33, 36, 37, 39, and 41-43 above, and further in view of Scheck et al. Scheck et al. discloses a metal plate 3 for mounting a motor (not shown, but see column 4, lines 65-67).

It would have been obvious to one of ordinary skill in the art to provide Basson et al., as modified above, with a metal plate, as taught by Scheck et al., to more securely mount the motor to the internal element.

Claims 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Basson et al. in view of Gonas as applied to claims 23, 24, 26-29, 31-33, 36, 37, 39, and 41-43 above, and further in view of Bertolini et al. Bertolini et al. discloses an internal element comprising a sealing body 11 mounted in a groove (not numbered, but shown in figure 7).

It would have been obvious to one of ordinary skill in the art to provide Basson et al., as modified above, with a sealing arrangement, as taught by Bertolini et al., to ensure that the dry and wet sides of the vehicle door are properly sealed.

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Claims 40 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Basson et al. in view of Gonas as applied to claims 23, 24, 26-29, 31-33, 36, 37, 39, and 41-43 above, and further in view of Ishikawa. Ishikawa, in figure 8, discloses an anchoring aperture (not numbered) surrounded by an integrally formed tab section 32 which projects from an end face (not numbered).

It would have been obvious to one of ordinary skill in the art to provide Basson et al., as modified above, with attachment means, as taught by Ishikawa, to more easily mount the internal element to the vehicle door.

Response to Arguments

Applicant's arguments filed March 30, 2005 have been fully considered but they are not persuasive.

With respect to the applicant's arguments concerning Basson et al., the examiner respectfully disagrees. Basson et al. discloses a sealing body 204 formed as a bead.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

It should be noted that the claims are considered to be product by process claims and as such are anticipated by the product as set forth in the rejection above.

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Accordingly, the applicant's comments that relate to how the internal element is formed are not persuasive since they are not supported by the claim language.

The applicant's comments concerning Marita et al., Wurm, Beaulat are moot in view of the new grounds of rejection.

The declaration of Mr. Johannes Hysky has been considered, however, the statements found therein are not persuasive because they are either moot in view of the new grounds of rejection or they are directed to the process by which the product is made.

Conclusion

THIS ACTION IS NOT MADE FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 571-272-6836. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Gregory J. Strimbu", with a stylized flourish at the end.

Gregory J. Strimbu
Primary Examiner
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July 9, 2005